

ATTORNEY DOCKET NO. 114596-07-4014

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/330,852 Confirmation No.: 9904
Applicant: David L. Reese, et al.
Title: PROFILING RANGES OF EXECUTION OF A COMPUTER PROGRAM
Filed: June 11, 1999 Art Unit: 2193
Atty. Docket: 114596-07-4014 Examiner: John Q. Chavis

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- Request for Withdrawal of Finality
- Request for Reconsideration
- Conditional Supplementary Amendment

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Respectfully submitted,

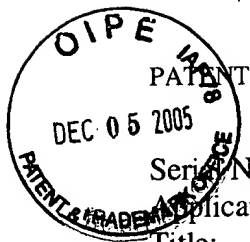
WILLKIE FARR & GALLAGHER LLP

Dated: November 30, 2005

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AFTER FINAL – EXPEDITED PROCEDURE

REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION

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Applicant observes that the Action of September 30, 2005 was prematurely made final. Pursuant to MPEP § 706.07(c) and (d), Applicant requests that the premature finality of the Action of May 10, 2002 be withdrawn, and that the Request for Reconsideration filed herewith be entered as of right.

I. The Office Action of September 2005 is Either Ambiguous and Incomplete or Raises a New Ground of Rejection – in Either Case, Final Rejection is Premature

The “double patenting” issue raised in paragraph 2 of the September 2005 Action is either not “clearly stated,” in which case final rejection is premature pursuant to 37 C.F.R. § 1.113(b), or is a “new ground of rejection” not necessitated by amendment, in which case final rejection is premature pursuant to MPEP § 706.07(a).

I certify that this correspondence, along with any documents referred to therein, is being deposited with the United States Postal Service on November 30, 2005 as First Class Mail in an envelope with sufficient postage addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

First, the “mirror image” issue in the ’401 application was withdrawn. 09/425,401, Notice of Allowance of 8/9/2005.

A. Procedural History

The Examiner’s email of 11/14/2005 demonstrates the even the Examiner is not sure which type of rejection is at issue. The email states:

I received your request to withdraw the Notice of Allowance for application 09/425,401. ... If the provisional rejection is a statutory type, then the other application should be cancelled. If the provisional rejection is a non-statutory type, then a terminal disclaimer is required for the second application to issue.

Even the Examiner cannot identify which type of double patenting is involved. How is an applicant to determine which course of action to take, when the Examiner can’t state which basis is involved, and what should be done to correct it?

No Office Action has never clearly stated whether the issue is “same invention” or “obviousness type” double patenting. Every one has clearly gone both ways. For example, paragraph 2 of the Action of April 2004 fails to use any of the required form paragraphs from MPEP § 804. Instead, that paper cites cases involving obviousness-type double patenting, but then uses words like “anticipated by,” “elimination of such claims,” and “cancellation,” which would only apply to statutory same-invention double patenting. The April 2004 Action was ambiguous.

The Action of January 2005 deepens the confusion. At page 3, ¶ 6 purports to reject only claims 1-30. This application had 51 claims pending at the time. The January 2005 Action repeats the mix-and-match of obviousness-type cases with same-invention type words such as “cancel the conflicting claims.” The January 2005 Action is ambiguous.

The Action of September 2005 is the first time any “terminal disclaimer” has been mentioned. Is this a shift to obviousness type double patenting? The September 2005 Action raises double patenting of claims 1-51, of which 31-51 are newly involved.

No Office Action has ever analyzed a particular claim to make a showing of element-by-element identity, or element-by-element obviousness, to any claim of the ’401 application. No Office Action has ever explained how every one of 51 claims of this application can possibly

correspond element-by-element (either identically or as an obvious variant) with only 30 claims of the '401 application.

B. The September 2005 Action Suggests Two New Grounds of Rejection

The September 2005 Action is the first to mention any “terminal disclaimer.” This is either a shift from same-invention to obviousness-type double patenting, or else a resolution of an ambiguity. In either case, if any rejection exists, it is a new ground of rejection.

The January 2005 Office Action only asserted double patenting against claims 1-30. The September 2005 Action adds claims 31-51. This is a “new ground of rejection.”

C. The September 2005 Action Is Too Incomplete to Raise Any Rejection at All, Let Alone Mature Into a Final Rejection

Even if double patenting rejection exists with respect to claims 1-51 (which it does not, see the accompanying Request for Reconsideration), the September 2005 paper is too unclear to raise any rejection. Any rejection that may exist is too unclear to support final rejection.

37 C.F.R. § 1.113(b) states as follows:

§ 1.113 Final rejection or action.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

There has been no “clear” statement of grounds, in this Action or in any other. Is this same-invention or obviousness-type double patenting? What claims are involved – how can every one of 51 claims of this application each be identically the same as, or an obvious variant of, a particular claim in the '401 application, when the '401 application only has 30 claims? What is the basis for the Examiner's view – without an element-by-element comparison of at least one particular claim of this application to one particular claim of the '401 application, what is the correspondence that is thought to apply?

Until some position is stated with sufficient specificity to allow an applicant to determine an appropriate response, no rejection exists. A non-rejection cannot mature into a final rejection.

II. The September 2005 Action Introduces Several New Grounds of Rejection Not Necessitated by Amendment

An Action may not be made final when it introduces a new ground of rejection, where the new ground was not necessitated by an amendment. MPEP § 706.07(a).

A “new ground of rejection” is any new line of reasoning that requires a “fair opportunity to react to the thrust of the rejection.” *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426 (CCPA 1976). For example, relying on new portions of the same references, for disclosure not found in portions previously relied on, is a “new ground of rejection.” *In re Wiechert*, 370 F.2d, 927, 933, 152 USPQ 247, 251-52 (CCPA 1967) (“An applicant's attention and response are naturally focused on that portion of the reference which is specifically pointed out by the examiner. ... [W]hen a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-à-vis such portion of the reference,” emphasis added).

A. New Grounds are Raised for a Number of Dependent Claims

This Office Action either shifts from § 103 to § 102, or adds totally new rejections of previously “unrejected” claims, for claims 4, 6 and 37. These are “new grounds of rejection not necessitated by amendment.” Final rejection is premature.

B. New Grounds of Rejection With Respect to Claim 2

On claim 2, the Office Action of September 2005 for the first time provides a “basis in fact and/or technical reasoning” to support its assertion of inherency. The Office Action of January 2005 did not do so, and thus raised no rejection at all. Because the January 2005 Action was too incomplete to raise any rejection at all, any rejection in September 2005 is necessarily “new.”

Further, the September 2005 Office Action is the first to note the relevance of Figs. 3, 4 and 8 to the “last byte” language of claim 2. This reliance on new portions of a reference is a “new ground of rejection” not necessitated by amendment.²

² *In re Wiechert*, 370 F.2d 927, 933, 152 USPQ 247, 251-52 (CCPA 1967) (“An applicant's attention and response are naturally focused on that portion of the reference which is specifically pointed out by the examiner. ... [W]hen a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-à-vis such portion of the reference”); *In re Echerd*, 471 F.2d 632, 635, 176 USPQ 321, 323 (CCPA

C. New Ground of Rejection With Respect to Claim 34

Applicant's paper of July 2005 noted that the language "without the program having been compiled for profiled execution" and "the recorded profile information being efficiently tailored ... to annotate the profiled binary code with sufficient processor mode information to resolve mode-dependency in the binary coding" of claim 34 had been entirely ignored in the Office Action of January 2005.

The September 2005 Office Action is the first to discuss this claim language. This is a "new ground of rejection" not necessitated by amendment. Final rejection is premature.

III. The September 2005 Action Is Insufficient to Raise Any Rejection of Claim 34, Let Alone Final

The September 2005 Office Action acknowledges that Heisch '033 is at best silent with respect to the claim language "without the program having been compiled for profiled execution." Page 3, lines 18-20, of the September 2005 Action. The Office Action makes no showing of inherency. Indeed, the Office Action accepts the showing in Applicant's July 2005 paper that the Heisch '033 could be read to use a program that has been "compiled for profiled execution."

Anticipation requires explicit or inherent disclosure. This Office Action does neither. No rejection may rely on mere silence of a reference. No rejection of claim 34 exists. A non-rejection may not be made final.

IV. Conclusion

For these reasons, the finality of the Action of September 30, 2005 should be withdrawn, the accompanying Request for Reconsideration should be entered as of right (even without a

1973) ("We find the new reliance [to be] a new ground of rejection. New portions of the reference are relied upon to support an entirely new theory... appellants should have been accorded an opportunity to present rebuttal evidence as to the new assumptions of inherent characteristics made by the board"), *reaffirmed by Kronig*, 539 F.2d at 1303, 190 USPQ at 427. The PTO's more-recent decisions regularly reinforce this principle. *E.g., Ex parte Kelcher*, Appeal No. 1999-1899, 2002 WL 63644 at *3-4, <http://www.uspto.gov/web/offices/dcom/bpai/decisions/fd991899.pdf> at 9-10 (BPAI Feb. 28 2001) (new reliance on an arrow in a figure of an existing reference is a "new ground of rejection"); *Ex parte D'Andrade*, Appeal No. 1999-1235, 1999 WL 33224326 at *3, .../fd991235.pdf at 7, 10 (BPAI Sep. 30, 1999) (shift from examiner's reliance on tension spring 59 to Board's reliance on tension spring 61 in the same single reference is a "new ground of rejection").

showing of reasons under Rule 116), and its remarks should be given the Examiner's full consideration.

It is believed that this paper occasions no fee. Kindly charge any fee due to Deposit Account No. 23-2405, Order No. 114596-07-4014.

Respectfully submitted,

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